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60683 7590 04/14/2009 HEALTH HERO NETWORK, INC. 2400 GENG ROAD, SUITE 200 PALO ALTO, CA 94303			EXAMINER KOPPIKAR, VIVEK D	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/810,334
Filing Date: March 14, 2001
Appellant(s): BROWN, STEPHEN J.

Christopher P. Maiorana
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 12, 2009 appealing from the Office action mailed October 17, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-16 and 18 are rejected under 35 U.S.C. 101 because the claims are directed towards a method of providing a method of customized health information to an individual but the claims do not recite a device (e.g. a computer) which is used for carrying out the method. Therefore, these claims are not tied to a statutory class of invention.

Claims 1-7 and 8 are rejected under 35 U.S.C. 101 because these claims are directed towards a server and it is ambiguous as to what a server exactly comprises and the Office takes the position that a server can comprise software and software, per se, is not a statutory category of patentable subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,584,445

Papageorge

10-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 10-16 and 18 are rejected under 35 U.S.C. 101 because the claims are directed towards a method of providing a method of customized health information to an individual but the claims do not recite a device (e.g. a computer) which is used for carrying out the method. Therefore, these claims are not tied to a statutory class of invention.

Claims 1-7 and 8 are rejected under 35 U.S.C. 101 because these claims are directed towards a server and it is ambiguous as to what a server exactly comprises and the Office takes the position that a server can comprise software and software, per se, is not a statutory category of patentable subject matter.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-7, 9-16 and 18-22 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Number 6,584,445 to Papageorge.

(A) As per claim 1, Papageorge teaches a server comprising:
a questionnaire generator for (i) generating a questionnaire comprising (a) one or more questions for determining an expression of risk for an individual (b) a first number of answer options to each of said questions and (c) one or more follow-up actions, wherein said expression of risk concerns at least one of a physical condition of said individual, a mental condition of said individual, and a behavior of said individual, (ii) associating each of said answer options with one of a second number of values representing a level of risk, said second number of values being greater than said first number of answer options and (iii) transmitting said questionnaire from said server to an apparatus, wherein said apparatus is (a) associated with said individual and (b) remotely located from said server (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33 and Col. 11, Ln. 15-30);

a database in a storage medium, said database containing model information relating to (i) an aspect of care, (ii) said expression of risk and (iii) said level of risk (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33);

and a profile generator for (i) generating a profile for said individual based on one or more of said aspects of care, responses to said questions, said expression of risk and said level of risk associated with said individual and (ii) sending health related information to said individual based on said profile, wherein data relating to said physical condition of said individual comprises patient information from one or more medical claims received by said server from a

medical claims paying organization associated with said individual (Papageorge: Col.8, Ln. 4-Col.9, Ln. 33).

(B) As per claim 2, in Papageorge the profile of said individual is updated based on one or more follow-up responses (Papageorge: Col. 8, Ln. 22-24).

(C) As per claim 3, in Papageorge the profile further comprises a language of said individual, and a current health condition of said individual and (ii) said questionnaire generator also tailors said questionnaire in dependence upon said language and said current health condition of said individual (Papageorge: Col. 7, Ln. 65-Col. 8, Ln. 4).

(D) As per claim 4, in Papageorge the questionnaire generator further generates a motivational profile and a comprehension capacity profile of said individual based on said responses to said questions received by 5 said server from said apparatus (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33).

(E) As per claim 5, in Papageorge the health related information comprises a request for additional responses; and educational information (Papageorge: Col. 7, Ln. 65-Col.8, Ln. 4).

(F) As per claim 6, in Papageorge the educational information is received by said server from an external source (Papageorge: Col. 7, Ln. 65-Col.8, Ln. 4).

(G) As per claim 7, in Papageorge the data relating to said physical condition of said individual further comprises one or more measurements received by said server from a monitoring device connected to said apparatus (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33).

(H) As per claim 9, in Papageorge the data related to said physical condition of said

individual further comprises medical information from electronic medical records received by said server from a services organization associated with said individual (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33).

(I) As per claim 10, Papageorge teaches a method for providing customized health information to an individual (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33), said method comprising the steps of:

(A) generating a questionnaire comprising (i) one or 5 more questions for determining an expression of risk for said individual (ii) a first number of answer options to each of said questions and (iii) one or more follow-up actions, wherein said expression of risk concerns at least one of a physical condition of said individual, a mental condition of said individual, and a behavior of said individual (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33);

(B) associating each of said answer options with one of a second number of values representing a level of risk, wherein said second number is greater than said first number (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33);

(C) transferring said questionnaire from a server to an apparatus, wherein said apparatus is (i) associated with said individual and (ii) remotely located from said server (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33);

(D) accessing a database in a storage medium, said database containing model information relating to (i) an aspect of care, (ii) said expression of risk and (iii) said level of risk (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33 and Col. 11, Ln. 21-22);

(E) generating a profile for said individual based on one or more of said aspects of care, responses to said questions, said expression of risk and said levels of risk associated with said individual(Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33 and Col. 11, Ln. 21-22) ; and
(F) sending health related information to said individual based on said profile, wherein data relating to said physical condition of said individual comprises patient information from one or more medical claims received by said server from a medical claims paying organization associated with said individual (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33 and Col. 11, Ln. 21-22).

(J) As per claim 11, in Papageorge there is a step of updating said profile after said server receives one or more follow-up responses (Papageorge: Col. 8, Ln. 21-25).

(K) As per claim 12, in Papageorge there is a step of registering a language of said individual, and a current health condition of said individual in said profile; tailoring said questionnaire to said individual in dependence upon said language and said current health condition of said individual (Papageorge: Col. 7, Ln. 65-Col. 8, Ln. 4).

(L) As per claim 13, in Papageorge the health related information comprises: a request for additional responses; and educational information (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33).

(M) As per claim 14, in Papageorge the educational information is received by said server from an external source (Papageorge: Col. 7, Ln. 65-Col. 8, Ln. 4).

(N) As per claim 15, in Papageorge there is a step of generating a report comprising said profile (Papageorge: Abstract and Col. 8, Ln. 4-Col. 9, Ln. 33).

(O) As per claim 16, in Papageorge the data relating to said physical condition further comprises one or more measurements received by said server from a monitoring device connected to said apparatus (Papageorge: Abstract and Col. 8, Ln. 4-Col. 9, Ln. 33).

(Q) As per claim 19, Papageorge teaches a storage medium for use in a server to communicate with one or more patient devices, the storage medium recording a computer program that is readable and executable by the server (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33), the computer program comprising the steps of:

(A) displaying a plurality of icons of a plurality of questions, a plurality of answers a plurality of follow-up actions and a plurality of follow-up answers (Papageorge: Abstract and Col. 8, Ln. 4-Col. 9, Ln. 33);

(B) receiving a selection to each of a particular question of said questions, a particular answer of said answers a particular follow-up action of said follow-up actions and a particular follow-up answer of said follow-up answers from a user (Papageorge: Abstract and Col. 8, Ln. 4-Col. 9, Ln. 33).;

(C) linking said icons of said particular question, said particular answer said particular follow-up action and particular follow-up responses (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33); and

(D) converting said linked icons into a questionnaire (Papageorge: Abstract and Col. 8, Ln. 4-Col. 9, Ln. 33).;

and

(E) transmitting said questionnaire to said one or more patient devices over a communication network (Papageorge: Abstract and Col. 8, Ln. 4-Col. 9, Ln. 33).

(J) As per claim 20, the computer program further comprises the step of: assigning a position of said particular answer along a risk scale ranging from a low risk value to a high risk value (Papageorge: Col. 11, Ln. 20-24).

(K) As per claim 21, Papageorge further comprising the steps of registering a language of an individual and a current health condition of said individual in a profile; and tailoring program to said individual in dependence upon said language and said current health condition of said individual (Papageorge: Col. 7, Ln. 65-Col. 8, Ln. 4).

(L) As per claim 22, Papageorge further comprising the step of simulating said questionnaire prior to said transmission of said questionnaire to said one or more patient devices (Papageorge: Col. 8, Ln. 4-Col. 9, Ln. 33).

(10) Response to Argument

Applicants arguments in the Appeal Brief filed on March 12, 2009 will be addressed in sequential order as they were presented in the Appeal Brief.

(1) Applicants argue that Papageorge does not teach a questionnaire generator, a database in a storage medium, or a profile generator, however, the Office would like to point out that Papageorge does in fact teach these features (Col. 6, Ln. 66-Col. 7, Ln. 25). The Office takes the position that the computerized health evaluation system taught in Column 1, Lines 10-

25 is a profile generator. Follow-up actions for the patient are taught in Column 7, Lines 15-24 of Papageorge.

(2) Applicants argue that Papageorge does not teach associating the answer options with a second number of values representing a level of risk and that the number of response options is less than a number of values representing a level of risk, however, Papageorge does in fact teach these features (Col. 9, Ln. 55-65). Papageorge also teaches that the database contains model information relating to (i) an aspect of care, (ii) an expression of risk and (iii) the level of risk (Col. 9, Ln. 55-65).

(3) Applicants argue that Papageorge does not teach the reception of medical claims, however, Papageorge does in fact teach this feature (Col. 5, Ln. 40-57).

(4) Applicants argue that Papageorge does not teach icons, however, the Office takes the position that these icons are taught in Papageorge (Figure 3 and Col. 6, Ln. 55-Ln. 65).

(5) Applicants argue that Papageorge does not teach (i) a particular question, (ii) a particular answer, (iii) a particular follow-up action and (iv) a particular follow-up answer; however the Office takes the position that these features are taught in Papageorge (Col. 6, Ln. 55-Col. 7, Ln. 25).

(6) Applicants argue that Papageorge does not teach linking icons. However, the Office would like to point out that Papageorge does in fact teach this feature (Col. 6, Ln. 55-Col. 7, Ln. 7). Applicants also argue that Papageorge also does not teach the step of converting icons into a questionnaire, however, the Office takes the position that Papageorge does in fact teach this feature (Col. 6, Ln. 55-Col. 7, Ln. 33).

(7) Applicants argue that Papageorge does not teach updated the profile based on one or more follow-up responses, however, the Office takes the position that Papageorge does in fact teach this feature (Col. 7, Ln. 8-24).

(8) Applicants argue that Papageorge does not teach (i) a language of the individual and a current health condition of the and a current health condition of the individual and (ii) that the questionnaire generator also tailors the questionnaire in dependence upon the language and the current health condition of the individual, however, the Office takes the position that Papageorge does in face teach this feature (Col. 6, Ln. 55-65).

(7) Applicants argue that Papageorge does not teach (i) a profile for the individual; (ii) a motivational profile and (iii) a comprehensive profile; however, the Office takes the position that Papageorge does in fact teach these profiles (Col. 4, Ln. 55-Col. 7, Ln. 25).

(8) Applicants argue that Papageorge does not teach that the health related information comprises a request for additional responses, however, the Office takes the position that this feature is taught in Papageorge (Col. 4, Ln. 55-Col. 7, Ln. 32).

(9) Applicants argue that Papageorge does not teach any type of monitoring device connected to the Internet terminal that could measure a parameter of a patient, however, the Office takes the position that Papageorge does in fact teach this feature (Col. 5, Ln. 29-40).

(10) Applicants argue that Papageorge does not teach any type of electronic medical records being provided by a services organization, however, the Office takes the position that this feature is taught in Papageorge (Col. 5, Ln. 40-57).

(11) Applicants argue that Papageorge does not teach simulations, however, the Office takes the position that Papageorge does in fact teach simulations (Col. 8, Ln. 47-49).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

(12) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Vivek D Koppikar/
Examiner, Art Unit 3686

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/
Director, TC 3600

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Paper No. 20090408

Art Unit: 3686

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Conferees:

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Group Art Unit 3686

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